



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,693	09/05/2003	Steven M. Blumenau	10830.0034CN	7170

27927 7590 09/26/2005

RICHARD AUCHTERLONIE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA
SUITE 5320
HOUSTON, TX 77002

EXAMINER

LANE, JOHN A

ART UNIT PAPER NUMBER

2188

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,693

Applicant(s)

BLUMENAU ET AL.

Examiner

Jack A. Lane

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/22/05;9/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-47 are presented for examination. The Examiner appreciates the guidance on locating support for claim elements present in the IDS submitted 09/05/03
2. The Examiner requests, in response to this Office action, any documentation known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent and dependent claims. That is, any prior art (including any documentation used to develop the disclosed/claimed subject-matter, background art and any products for sale) similar to the claimed invention that could reasonably be used in a 102 or 103 rejection. The Examiner is specifically looking for a map (table, etc) that maintains information that enables or does not enable access to a logical storage device. This request does not require a search. Support for this request is derived from 37 C.F.R. 1.56 and 1.105, however, it is not intended to interfere with or go beyond that required under 37 C.F.R. 1.56 or 1.105.

In the present application, a large number of prior art references (i.e. over 100) have been submitted for consideration in the IDS filed 09/05/03 and 12/22/04. In response to this Office action, the Examiner requests a discussion of which, if any, presently claimed features correspond to prior art elements in the IDS documentation. Specifically, the Examiner is looking for the map discussed above.

The request may be fulfilled by asking the attorney(s) of record handling prosecution and the inventor(s)/assignee for references qualifying as prior art. A simple statement that the query has been made and no prior art found is sufficient to fulfill the request. Otherwise, the fee and

certification requirements of 37 CFR section 1.97 are waived for those documents submitted in reply to this request. This waiver extends only to those documents within the scope of this request that are included in the Applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this request and any information disclosures beyond the scope of this request are subject to the fee and certification requirements of 37 CFR section 1.97.

In the event documentation (e.g. newly submitted/previously submitted on an IDS, incorporated by reference or "common knowledge" generally found in the background section but not a publication) is determined to qualify as prior art, a discussion of relevant passages, figs. etc. with respect to the claims must be provided. The Examiner is looking for specific references to 102/103 prior art that identify independent and dependent claim limitations. Since Applicant is most knowledgeable of the present invention and submitted art, a discussion of the reference(s) with respect to the instant claims is essential.

The Examiner also requests, in response to this Office action, a showing of support for the following: Claim language added to any present claims on amendment and any new claims. That is, indicate support for claim language by specifically pointing to page(s) and line no(s). in the specification and/or drawing figure(s). This will assist in prosecuting the application. Here again, this request is derived from 37 C.F.R. 1.105.

When responding to the Office action, Applicant is advised to clearly point out the patentable novelty the claims present in view of the state of the art disclosed by the reference(s) cited or the objections made. A showing of how the amendments avoid such references or objections must also be present. See 37 C.F.R. 1.111(c).

When responding to this Office action, Applicant is advised to provide the line and page numbers in the application and/or reference(s) cited to assist in locating the appropriate paragraphs.

3. Claims 1, 20 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 22 and 34 of U.S. patent application no. 10/139,490. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 8, 22 and 34 of application no. 10/139,490 contain every element of at least claims 1, 20 and 33 of the instant application and as such anticipates claims 1, 20 and 33 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “**ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Present application claims 1, 20 and 33 and application 10/139,490 claims 8, 22 and 34 recite “hosts”, “data storage” and “mapping...host...storage.”

Claims 1, 20 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 7 and 12 of U.S. patent no. 6,421,711. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent claims 2, 7 and 12 contain every element of at least claims 1, 20 and 33 of the instant application and as such anticipates claims 1, 20 and 33 of the instant application.

Present claims 1, 20 and 33 and patent claims 8, 22 and 34 recite “hosts”, “data storage” and “mapping...host...storage.”

4. Claims 1-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 20 and 33, the claim language “conforming with” is unclear. The specification does not provide antecedent basis for this language.

The remaining claims are rejected as they depend from a rejected base claim.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanada et al. (Pat. No. 6,484,245).

Sanada teaches the claimed “plurality of hosts” as host computers 10, 20 and/or 30 (fig.

1). The claimed “plurality of data storage devices” corresponds to logical units 51, 52. The claimed “apparatus coupling the hosts and the data storage devices” corresponds to storage

Art Unit: 2188

controller 40. The claimed "hosts ports" corresponds to fiber channel control unit 41. The claimed "mapping of the hosts to respective logical storage units" corresponds to control/management tables 140 or 160. The claimed function of determining "conformance with the mapping" corresponds to comparing N_Port_Name, N_Port_ID and/or LUN number with information maintained in the control/management table. Access to storage 51, 52 is granted based on the result of the comparison.

The examiner believes all dependent claim features not specifically discussed above are expressly or inherently taught by Sanada. The remaining dependent claim features, while part of the invention, do not appear essential to the main invention found in the independent claims. Thus, a detailed discussion of claim feature(s) is not warranted at this time.

Any response to this action should be mailed to:

Under Secretary of Commerce for Intellectual Property and Director of the
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

or faxed to:

(571) 273-8300, (for Official communications intended for entry)

Or:

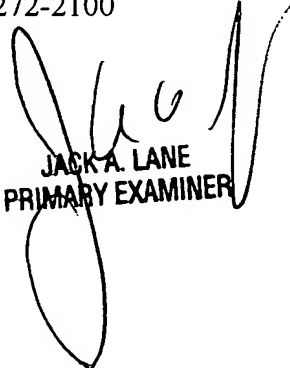
(571) 273-4208, (for Non-Official or draft communications, please label
"Non-Official" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack A. Lane whose telephone number is 571 272-4208. The examiner can normally be reached on Mon-Fri from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 571 272-4210.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272-2100


JACK A. LANE
PRIMARY EXAMINER